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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/629,364	07/29/2003	Richard G. Morton	2001-0138-03	6284
21773	7590	04/14/2005	EXAMINER	
CYMER INC LEGAL DEPARTMENT 17075 Thornmint Court SAN DIEGO, CA 92127-2413			TALBOT, BRIAN K	
			ART UNIT	PAPER NUMBER
			1762	

DATE MAILED: 04/14/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/629,364

Applicant(s)

MORTON ET AL.

Examiner

Brian K. Talbot

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 January 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 25-31 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 25-27 and 31 is/are rejected.
- 7) ☐ Claim(s) 28-30 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 2/17/04.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____

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1. The Election filed 12/4/04 has been considered and entered. Claims 1-24 and 32-52 have been canceled. Claims 25-31 remain in the application.

Double Patenting

2. Claims 25-31 are provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 23-28 of copending Application No. 10684,016 and claims 23-28 of 09/953,026. This is a provisional double patenting rejection since the conflicting claims have not in fact been patented.

A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 25-31 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

With respect to claim 25 and 31, the terms “fabricating”, “operating” and “creating” are vague and indefinite as the claim fails to recite how these processes are performed.

With respect to claim 26, the claim is unclear. The Examiner questions how “operating the electrode ...” would create a porous layer? The process steps in forming this layer need to be claimed (see claim 28).

With respect to claims 28 and 31, the claim is unclear. The Examiner questions how “mixing insulating particles and molten metal...” produces a discharge section of the electrode? Is the “mixture” applied to a substrate to form the electrode? Is the “mixture” molded? Clarification is requested.

With respect to claims 29-30, the term “dimensions” is unclear. What does the term “dimension” encompass? Diameter? Height? Width? Clarification is requested.

5. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 25-27 and 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Otto et al. (3,828,277), Dvorkin (5,771,259) or JP 01-154,577.

Otto et al. (3,828,277) teaches a capacitor discharge laser whereby the electrode is coated with a ceramic dielectric layer (abstract).

Dvorkin (5,771,259) teaches a laser electrode coating whereby dual layer of materials are applied to the electrode. The dual layer comprises a catalyst layer and a dielectric layer. (see abstract).

JP 01-154,577 teaches a mica coating layer around an auxiliary electrode for a discharge laser (see constitution).

Otto et al. (3,828,277), Dvorkin (5,771,259) or JP 01-154,577 all fail to teach an “elongated” electrode with a length of at least 50 cm and a width of 3 mm.

While the Examiner acknowledges this fact, it is the Examiner’s position that “elongated electrodes” are conventional in the art concerning laser discharge devices. Hence, the claimed dimensions would have been an obvious modification of the prior art as well as the fact that one

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skilled in the art would have optimized the dimensions of the electrode depending upon the desired end product.

With respect to the claims 27 and 31, the process of applying particles of a coating material to form a layer is commonplace in the art and would have been expected to produce the similar results regardless of the technique utilized.

Allowable Subject Matter

7. The following is a statement of reasons for the indication of allowable matter:

The prior art while teaching coating an electrode in a laser discharge device with a dielectric layer, the prior art fails to teach the claimed process for producing the dielectric layer as claimed in claim 28.


Claims 28-30 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian K. Talbot whose telephone number is (571) 272-1428. The examiner can normally be reached on Monday-Friday 6AM-3PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Timothy H. Meeks can be reached on (571) 272-1423. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

 4/1/05
Brian K Talbot
Primary Examiner
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BKT